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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/119,209 07/20/98 LASKY

L 565D1C3

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HM12/1213

EXAMINER

PAK, M

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

12/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/119,209

Applicant(s)
Laskey et al.

Examiner
Michael Pak

Group Art Unit
1646



☒ Responsive to communication(s) filed on Oct 25, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 49-56 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 49-56 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 25 October 1999 (Paper No. 6) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/119,209 is acceptable and a CPA has been established. An action on the CPA follows.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The Preliminary amendment filed 20 July 1998 (Paper NO. 2) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows.

The incorporation by reference of parent application is objected to as introducing new matter into the specification.

Applicant is required to cancel the new matter in the response to this Office action.

Double Patenting

4. Claims 49-56 are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,216,131. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-16 of the issued U.S. Patent No. 5,216,131.

The terminal disclaimer filed by the applicant in the parent application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

5. Claims 49-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,840,844. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-13 of the issued U.S. Patent No. 5,840,844.

The terminal disclaimer filed by the applicant in the parent application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

6. Claims 49-56 are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 5,098,833. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to It would be obvious to one of ordinary skill in the art to use the process of claims 16-20 and the DNA and vector of claims 1-15 and 21-32 of the issued U.S. Patent No.5,840,844 to isolate the LHR protein of the claims 49-56 of the present application.

The terminal disclaimer filed by the applicant in the parent application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

Claim Rejections - 35 USC § 102

7. Claims 49-51 and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

Woodruff et al. disclose the human lymphocyte homing receptor (pages 216-218)

The human lymphocyte homing receptor(hLHR) inherently has the same structure and sequence as the claimed sequence because the receptor was identified using the same technique as the mouse and rat and is isolated from the T-cells as are all other LHRs.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jalkanen et al. (IDS references 17-20) are cumulative reference with Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

9. No claim is allowed.

10. This is a continued prosecution application of applicant's earlier Application No. 09/119,209. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to

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(703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak

Michael D. Pak
Primary Patent Examiner
Art Unit 1646
7 December 1999